

REMARKS

Claims 1-21, 47-49, 52-54, 57-64, 66-68, 70-72 and 74-79 are pending in this application. By this Amendment, Claim 1 has been amended, Claims 19-21 have been canceled without prejudice and new Claims 80 and 81 have been added. Independent Claim 1 has been amended to more particularly point out the invention, by specifying that the reaction product is from about 40 to about 70% esterified. Support for the amendment to Claim 1 can be found throughout the specification, e.g., on page 29, lines 1-4 of the specification, and in canceled Claim 21. Support for new Claims 80 and 81 can be found, e.g., on page 27, lines 10-13 and page 29, lines 1-4 of the specification. Applicants respectfully submit that no new matter has been added to this application. Moreover, it is submitted that the claims as now presented place the subject application in condition for immediate allowance.

In the last Office Action mailed June 19, 2006, the Examiner noted that the Information Disclosure Statement filed on March 11, 2005 failed to comply with 37 C.F.R. §1.98(a)(3), because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 C.F.R. §1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Specifically, it was the Examiner's belief that no explanation of the relevance of foreign language reference EP 658572 has been provided and therefore this reference has not been considered. Applicant submits herein an Information Disclosure Statement citing foreign language reference EP 658572 and includes an English translation thereof. Applicant also respectfully submits that EP 658572 discloses an ashless, detergent-dispersant additive composition containing a polyolefin succinic acid anhydride derivative obtained by reacting a polyolefin succinic acid anhydride intermediate

with one or more at least bifunctional compounds containing amine and/or hydroxyl groups to provide an additive having a polyimide, polyamide, polyester and/or polyesteramide structure as a final product. EP 658572 further discloses that in the process of preparing the polyolefin succinic acid anhydride intermediate, compounds that adversely affect the reaction rate are added to the reaction in order to reduce and prevent undesirable side reactions such as homopolymerization, copolymerization, alternating polymerization, decarboxylation and resin formation. In addition, EP 658572 discloses intermediates, final products and their preparation procedures prepared according to the invention as compared to known compositions and processes. Accordingly, it is believed that applicant has fully complied with the requirement of 37 C.F.R. §1.98(a)(3). Thus, it is respectfully requested that the Examiner consider this reference.

In the last Office Action mailed June 19, 2006, the Examiner finally rejected original Claims 1, 2 and 9-21 under 35 U.S.C. §102 (e) as being anticipated by Harrison et al. U.S. Patent No. 6,451,920 ("Harrison et al."). Of these claims, Claim 1 has been amended to include the limitation of Claim 21 and Claims 19-21 have been canceled.

It is well established that for a prior art reference to evidence lack of novelty (anticipation) of the subject matter of a claim under 35 U.S.C. §102, each and every element as set forth in the claim must be either expressly or inherently described in a single prior art reference. *Verdegall Brothers, Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987).

Nowhere do Harrison et al. disclose an esterified polyalkene/unsaturated acidic reagent copolymer which is the reaction product of a polyol and a copolymer of the specifically recited

formula *wherein the reaction product is from about 40 to about 70% esterified* as presently set forth in amended Claim 1. Rather, Harrison et al. simply disclose that polyesters can be prepared by reacting a polyPIBSA/acid-catalyzed thermal PIBSA mixture with a polyol. At no point is there any disclosure in Harrison et al. of how much of the polyPIBSA is esterified. Accordingly, since Harrison et al. do not disclose an esterified polyalkene/unsaturated acidic reagent copolymer which is the reaction product of a polyol and a copolymer of the specifically recited formula *wherein the reaction product is from about 40 to about 70% esterified* as presently set forth in amended Claim 1, Claims 1, 2 and 9-18 are not anticipated by Harrison et al. Thus, withdrawal of the rejection of amended Claims 1, 2 and 9-18 under 35 U.S.C. §102 (e) is respectfully requested.

With respect to new Claims 80 and 81, Harrison et al. likewise do not disclose an esterified polyalkene/unsaturated acidic reagent copolymer which is the reaction product of a polyol and a copolymer of the specifically recited formula *wherein the reaction product is from about 40 to about 70% esterified and has a number average molecular weight of about 5,000 to about 25,000*. Rather, as stated above, Harrison et al. simply disclose that polyesters can be prepared by reacting a polyPIBSA/acid-catalyzed thermal PIBSA mixture with a polyol. In lacking any disclosure of the presently recited esterified polyalkene/unsaturated acidic reagent which is from about 40 to about 70% esterified and has a number average molecular weight of about 5,000 to about 25,000, new Claims 80 and 81 are also not anticipated by Harrison et al. Thus, immediate allowance of new Claims 80 and 81 is respectfully requested.

In the last Office Action mailed June 19, 2006, the Examiner finally rejected Claims 3-8, 47-49, 52-54, 57-64, 66-68, 70-72 and 74-79 under 35 U.S.C. §103 (a) as being obvious over Harrison et al.

Harrison et al. likewise provides no suggestion, motivation or even a hint of the specifically recited esterified copolymer as presently set forth in amended Claim 1, from which Claims 3-8 depend. Nor, for that matter, is there any suggestion, motivation or even a hint in Harrison et al. of the specifically recited esterified copolymer as presently set forth in new Claims 80 and 81.

Rather, Harrison et al. merely disclose that a polyester can be prepared by reacting a polyPIBSA/acid-catalyzed thermal PIBSA mixture with a polyol. At no point is there any suggestion, motivation or even a hint in Harrison et al. of providing a polyPIBSA which is about 40 to about 70% esterified or, for that matter, a polyPIBSA which is about 40 to about 70% esterified and has a number average molecular weight of about 5,000 to about 25,000. Instead, the primary goal of Harrison et al. is to improve the conversion of the polybutene starting material and not at all to the reaction product obtained from a reaction of the recited copolymer with a polyol. Thus, nothing in Harrison et al. would lead one skilled in the art to modify the reaction product of the polyPIBSA/acid-catalyzed thermal PIBSA mixture with a polyol as disclosed therein and arrive at the presently recited esterified copolymer of amended Claim 1 which is from about 40 to about 70% esterified, from which Claims 3-8 depend. Nothing in Harrison et al. would lead one skilled in the art to modify the reaction product of the polyPIBSA/acid-catalyzed thermal PIBSA mixture with a polyol as disclosed therein and arrive

at the presently recited esterified copolymer of new Claims 80 and 81 which is about 40 to about 70% esterified and has a number average molecular weight of about 5,000 to about 25,000.

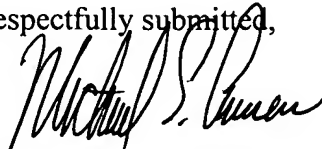
Since Harrison et al. provide no suggestion or motivation of the specifically recited esterified copolymer of amended Claim 1 from which Claims 3-8 depend, Claims 3-8 are believed to be non-obvious, and therefore patentable, over Harrison et al. Additionally, since Harrison et al. provide no suggestion or motivation of the specifically recited esterified copolymer of new Claims 80 and 81, new Claims 80 and 81 are believed to be non-obvious, and therefore patentable, over Harrison et al. Accordingly, withdrawal of the rejection of Claims 3-8 and new Claims 80 and 81 under 35 U.S.C. §103 (a) is respectfully requested.

Claims 47-49, 52-54, 57-64, 66-68, 70-72 and 74-79, which ultimately depend from amended Claim 1, are believed to allowable for at least the same reasons as amended Claim 1. Specifically, as Harrison et al. provide no suggestion or motivation of the specifically recited esterified copolymer of amended Claim 1, one skilled in the art would not be motivated to employ the recited esterified copolymer as a lubricating oil or fuel additive. Accordingly, Claims 47-49, 52-54, 57-64, 66-68, 70-72 and 74-79 are also believed to patentable over Harrison et al. and withdrawal of the rejection of Claims 47-49, 52-54, 57-64, 66-68, 70-72 and 74-79 under 35 U.S.C. §103 (a) is respectfully requested.

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For the foregoing reasons, amended Claims 1-18, 47-49, 52-54, 57-64, 66-68, 70-72 and 74-79 and new Claims 80 and 81 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael E. Carmen", written over the typed name.

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